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REMARKS

Claims 9, 10, 12-15, 17, 18, 21, 22, 24-27, 29-31, 33-36, 38, 39 and 41-56 remain pending.

Upon further consideration, Applicant is entitled to broader claims than those indicated as allowable in the Notice of Allowance mailed September 24, 2004. Applicant hereby expressly disclaims all previous remarks and amendments in this application to date.

In the Office Actions mailed June 4, 2003, and April 22, 2004, the Examiner rejected at least the independent claims under 35 U.S.C. § 102(e) and/or 35 U.S.C. § 103(a) as being unpatentable over Kotha et al. (U.S. Patent No. 5,521,614) with and without Bugg (U.S. Patent No. 5,016,000).

Claims 9, 10, 12, 13, 21, 22, 24, 25, 41, 42, 44, 45, 51, and 53:

Applicant respectfully traverses any rejection of claims 9, 10, 12, 13, 21, 22, 24, 25, 41, 42, 44, 45, 51, and 53 based on Kotha et al. Independent claims 9 and 21 require a method and program storage device including, *inter alia*, "forming a horizontal expansion pattern . . . based on character code and row number of the text character cell." Kotha et al. fails to teach or suggest all elements of claims 9 and 21.

Page 4 of the Final Office Action mailed April 22, 2004, alleges that "Kotha inherently suggests that the cell row number is used to form the horizontal expansion pattern." M.P.E.P. § 2112 mandates that "In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art." *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990) (emphasis in original). Rather than the expansion pattern in Kotha et al., "necessarily" being based on the row number, Kotha et al. explicitly teaches that an expansion pattern that is *not* based on the row number.

Fig. 7A of Kotha et al. that shows a hardware text expander does not have an input for row number. Hence, it performs the same operation regardless of row number. See col. 7, lines 37-39, and col. 5, lines 57-59. Because the expander in Fig. 7A of Kotha et al. operates the same

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regardless of what row number is being processed, Kotha et al. explicitly teaches and suggests forming a horizontal expansion pattern *not* "based on row number."

Because Kotha et al. fails to teach or suggest all limitations of claims 9 and 21, a *prima facie* case of unpatentability cannot be established for these claims. Bugg fails to cure this deficiency of Kotha et al. Claims 10, 12, 13, 22, 24, 25, 41, 42, 44, 45, 51, and 53 are allowable at least by virtue of their dependency from claims 9 and 21.

Claims 14, 15, 17, 18, 26, 27, 29-31, 33-36, 38, 39, 43, 46-50, 52, and 54-56:

Applicant respectfully traverses any rejection of claims 14, 15, 17, 18, 26, 27, 29-31, 33-36, 38, 39, 43, 46-50, 52, and 54-56 based on Kotha et al. and Bugg. Independent claims 14, 26, 30, and 35 require a method, program storage device, and apparatus including that, *inter alia*, "the horizontal expansion pattern is contained in lookup tables indexed by the character code and the row number." The combination of Kotha et al. and Bugg fails to teach or suggest all elements of claims 14, 26, 30, and 35.

Page 6 of the Final Office Action mailed April 22, 2004, admits that Kotha et al. fails to teach the claimed horizontal expansion pattern contained in lookup tables indexed by the character code and the row number. Even if Bugg taught or suggested such an indexing scheme, Kotha et al. would teach away from any proposed combination. As explained above, Kotha et al. fails to teach or suggest doing anything based on the row number. Rather, it teaches only a fixed, hardware solution for padding horizontal portions. Hence, Kotha et al. teaches directly away lookup tables in general, and those using a row number in particular.

Because a combination of Kotha et al. and Bugg fails to reasonably teach or suggest all limitations of claims 14, 26, 30, and 35, a *prima facie* case of unpatentability cannot be established for these claims. Claims 15, 17, 18, 27, 29, 31, 33, 34, 36, 38, 39, 43, 46-50, 52, and 54-56 are allowable at least by virtue of their dependency from claims 14, 26, 30, and 35.

Reconsideration and allowance of pending claims 9, 10, 12-15, 17, 18, 21, 22, 24-27, 29-31, 33-36, 38, 39 and 41-56 is respectfully requested.


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In the event that any outstanding matters remain in this application, Applicant requests that the Examiner contact Alan Pedersen-Giles, attorney for Applicant, at the number below to discuss such matters.

To the extent necessary, a petition for an extension of time under 37 C.F.R. § 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account No. 50-0221 and please credit any excess fees to such deposit account.

Respectfully submitted,

Dated: December 23, 2004



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